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### REMARKS

In response to the Office Action dated August 1, 2005 ("the Action"), Applicant respectfully requests reconsideration based on the above claim amendments and the following remarks. Applicant respectfully submits that the claims as presented are in condition for allowance.

Claims 1-20, 27, 28, and 30-40 are pending in the application but stand rejected as being obvious over U.S. Patent No. 5,663,711 to Sanders et al. ("Sanders") alone or in combination with other secondary references. Applicant respectfully disagrees.

#### I. Claims 1-5, 14-19 and 37-38

##### Claim 1

Regarding Claim 1, the Action concedes that Sanders fails to teach or suggest a single-use device that is disposable after a power disruption. The Action then opines that "it would have been obvious to dispose the device ...for the purpose of preventing failure detecting situation because when the power is disrupted, that may destroy the system and it will not work like normal" (Action, p. 3). The Action goes on to allege that if and when a user decides to dispose a device after a single use the user could dispose the device because it is user's choice to do so (Action, p. 3). Applicant respectfully disagrees.

Sanders teaches away from a single-use disposable device because it includes a power reset switch 50 connected into the alert circuit that is reset by a reset button 52 projecting from the front of the housing (col. 2, lines 38-41). The Action is overly broad in opining that a mere fact that someone could throw the Sanders device away after a single use somehow teaches or suggests to do so, when the device is clearly a multi-use device. Applicant again submits that Claim 1 is patentable over the cited reference.

##### Claim 37

Regarding Claim 37 (and 32), the multi-use device with the reset proposed by Sanders fails to teach or suggest, and indeed teaches away from, configuring the circuit to intentionally impair or destroy a component to limit reuse after a power outage. Applicant again submits that Claim 37 (and related method Claim 32) is patentable over Sanders.

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#### Claims 16-19

Regarding Claims 16-19, the Action concedes that Sanders fails to disclose the claimed size, shape and weight, but alleges that it would have been an "obvious matter of design choice... since such a modification would have involved a mere change in size of a component" (Action, p.5). The Action states that a change in size is generally recognized as being within the level of ordinary skill in the art and cites *In re Rose*, 105 USPQ 237 (CCPA 1955) in support of this position. Applicant respectfully disagrees.

Sanders proposes a box-like device with a mounting bracket on the top rear surface of the device. Such an additional mounting bracket inherently denotes that the device is relatively heavy. Further, as shown in Figure 1, the proposed device is relatively tall and would appear to occlude an entire wall socket. In addition, there are forward and side mounted electrical outlets 30, 32, and piezoelectric transducer 48 (col. 2) and a 9V battery 70 "which powers the audible alarm circuit" (col. 3, lines 5-6) and the like, again making the device much heavier and larger (and more expensive) than the device claimed in Claims 16-19. Further, the claims are not merely related to a change in "size", but rather are directed to subject matter that provides functional and aesthetically pleasing features.

The devices of the instant invention are alert devices and not intended for power back up (particularly for critical needs) but merely as inexpensive courtesy alarms for non-critical needs (p. 4 of the application). Generally stated, the present invention is directed to light-weight, low-cost power failure alert devices that can promote increased consumer usage and can be used on GFI circuits. The devices are compact devices that may use and/or occlude only a single plug in a standard wall socket and are sized so as not to cover both plug-ins of the standard dual plug-in socket.

Notably, as shown in Figure 2 of the pending application (and recited in Claims 16 and 18) in some embodiments, the device is configured to be generally coextensive with a portion of the electrical cover plate to thereby allow visual access to the GFI reset on the electrical cover plate. Claims 16-19 are restated below for ease of discussion.

16. A power disruption alert device according to Claim 1, wherein the housing has a forward surface with a height and width defining a surface area that is

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less than about 14 in<sup>2</sup>, wherein the housing is compactly configured with bounds thereof being substantially coextensive with a portion of an electrical socket cover plate to allow visual access to a GFI reset on the electrical socket cover plate, and wherein the device has a weight that is self-supported upon plug into an electrical socket in the electrical socket cover plate.

17. A power disruption alert device according to Claim 1, wherein the housing has a forward surface with a height and width, each being less than about 3 inches, and a depth of less than about 1 inch, and wherein the housing has a single electrical socket thereon, accessible on the forward surface thereof.

18. A self-contained power disruption alert device, comprising:  
a housing with a plurality of male conductors extending outwardly therefrom, the male conductors sized and configured to enter an electrical wall outlet to be in electrical communication therewith;

an electronic circuit in the housing and configured to respond to a power disruption in the electrical wall outlet;

a battery receiving space disposed on and/or in the housing and sized and configured to hold a battery to be in electrical communication with the electronic circuit to power the electronic circuit; and

a speaker in communication with the electronic circuit, wherein, in operation, an audible alert is output by the speaker when power to the electrical wall outlet is disrupted,

wherein the device is self-contained, wherein the housing has a forward surface with a height and width defining a surface area that is less than about 14 in<sup>2</sup>, wherein the housing is compactly configured with bounds thereof being substantially coextensive with a portion of an electrical socket plate so as to allow external visual access to a GFI reset on the electrical socket plate, wherein the device has a weight that is self-supported upon plug into an electrical socket in the electrical socket plate, and wherein the device without a battery weighs less than about 8 ounces.

19. A power disruption alert device according to Claim 18, wherein the device comprises a single female electrical receptacle outlet, and wherein the device with a battery weighs less than about 8 ounces.

Applicant respectfully submits that the above claims<sup>1</sup> are patentable for at least the features emphasized above, as Sanders teaches away from the claimed compact, light-weight device.

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<sup>1</sup> Applicant also submits that Claims 39 and 40 are also patentable for at least the features noted with respect to Claims 18 and 19 respectively.

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## II. Claims 12-13, 22 and 30-36

The Action rejects Claims 12-13, 22 and 30-36 over Sanders in view of U.S. Patent No. 4,987,402 to Nykerk ("Nykerk"). The Action concedes that Sanders fails to teach or suggest the use of audible recorded messages in response to a power disruption. However, the Action states that Nykerk teaches a security system with a voice synthesizer with prerecorded messages and opines that it would have been obvious to use the design of Nykerk in the system of Sanders to provide a plurality of prerecorded messages during various states of power disruption (Action, p. 7). Applicant respectfully disagrees.

Nykerk is directed to a relatively complex (and more costly) alarm system *with a proximity detector that generates vocal warnings to instruct an intruder to "back away" before the alarm is triggered*. Nykerk is not concerned with a small battery for power, power consumption, power outages, weight or size constraints contemplated by the compact, economical power outage device of the instant invention. Applicant submits that one of skill in the art would not have modified Sanders in the manner noted absent the teachings of the present invention. Further, Nykerk issued in 1991 and Sanders issued in 1997, and both are notably silent with respect to using messages in a power outage. In addition, the vocal messages proposed by Nykerk relate to theft situations. As such, even combined, the references do not teach or suggest having the messages formulated as recited in the dependent claims, for example, different messages for longer and shorter power outages, messages for each of power outages or low power, messages interspersed with non-message signals or the recitations of Claims 34-36. Claims 12 and 13 (as amended in a non-narrowing manner for clarity hereinabove) and Claims 22, 31, 32 and 34-36 are restated here for ease of discussion.

12. A self-contained power disruption alert device, comprising:
  - a housing with a plurality of male conductors extending outwardly therefrom, the male conductors sized and configured to enter an electrical wall outlet to be in electrical communication therewith;
  - an electronic circuit in the housing and configured to respond to a power disruption in the electrical wall outlet, wherein the electronic circuit comprises at least one pre-recorded message;
  - a battery receiving space disposed on and/or in the housing and sized and configured to hold a battery to be in electrical communication with the electronic circuit to power the electronic circuit; and

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a speaker in communication with the electronic circuit, wherein, in operation, the speaker is configured to output the pre-recorded voice message as an alert when power to the electrical wall outlet is disrupted.

13. A power disruption alert device according to Claim 12, wherein the electronic circuit comprises a microprocessor configured with electronic memory having the at least one prerecorded message that is configured to be transmitted during a power disruption.

22. A method for generating an alert when power is disrupted to an electrical outlet, comprising:  
mounting a self-contained power disruption alert device to an electrical outlet;  
electronically selecting a pre-recorded voice message from one of a plurality of pre-recorded voice messages stored in the device; and  
automatically transmitting the selected pre-recorded voice message when power to the electrical outlet is disrupted.

31. (Currently Amended) A method according to Claim 22, wherein the mounting step is carried out by inserting male conductors into a female outlet in a dual outlet wall cover panel, wherein the alert device has a forward surface with a height and width, each being less than about 3 inches, and a depth that is less than about 1 inch, wherein the device provides a single female electrical receptacle and is substantially coextensive with a portion of the wall female electrical outlet cover panel, and wherein the alert device without a battery weighs less than about 8 ounces.

34. A device according to Claim 13, wherein the at least one pre-recorded message is a plurality of different pre-recorded messages, at least one for alerting of a power outage and another at least one alerting of a low battery condition.

35. A device according to Claim 13, wherein the at least one pre-recorded message is a plurality of different pre-recorded messages including a message for longer power outages that is different from the message for a shorter power outage.

36. A device according to Claim 13, wherein the at least one message is interspersed with loud audible signals thereby providing increased impact and noise alerts.

Applicants submit that the above claims are patentable over the cited references for at least the emphasized features.

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Applicants respectfully submit that to establish a *prima facie* case of obviousness under 35 U.S.C. §103(a), the prior art reference or references when combined must teach or suggest all the recitations of the claim, and there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. M.P.E.P. § 2143. Further, the mere fact that known principles are employed cannot render the invention obvious; most inventions employ known principles. *Lindemann Maschinenfabrik v. American Hoist & Derrick Co.*, 221 U.S.P.Q. 481, 489 (Fed. Cir. 1984). The standard of obviousness is not whether, in hindsight, someone would have combined elements to form the invention. *W.L. Gore & Associates v. Garlock, Inc.*, 220 U.S.P.Q. 303, 312-313 (Fed. Cir. 1983). Simplicity alone cannot be determinative of obviousness. *Gentry Gallery, Inc. v. Berkline Corp.*, 45 U.S.P.Q.2d 1498 (Fed. Cir. 1998).

It is also noted that a prior art reference must be considered as a whole, including portions that would lead away from the claimed invention. See MPEP § 2141.02 (citing *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540 (Fed Cir. 1983), *cert. denied*, 469 U.S. 85 (1984)). Nykerk teaches the use of vocal messages to scare potential intruders away from cars and the like, NOT to warn of power outages. Nykerk uses a proximity sensor to trigger such an alarm. One of skill in the art would not have included vocal power outage warnings on compact power outage (GFI) devices absent the teachings of the present invention.

In addition, the Action alleges with respect to the obviousness of the claimed subject matter recited in Claims 34-36 that, "specific triggering conditions and type of alerts would have been an obvious design consideration based on the magnitude of the necessary alert" (Action, p. 8). Applicant respectfully disagrees and submits that this allegation is merely conclusory and without proper basis as there is no support for this allegation in the cited references.

In view of the foregoing, Applicant respectfully submits that Claims 12-13, 22 and 30-36 are in condition for allowance; which action is requested.

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### III. Claims 20 and 23

The Action rejects Claims 20 and 23 over Sanders in view of U.S. Patent Application Publication No. 2002/0118498 to Nordling ("Nordling"). The Action states that since Nordling proposes converting electrical outlets to GFI outlets, the claimed subject matter of Claims 20 and 23 would have been obvious. Applicant respectfully disagrees. Applicant concedes that the use of GFI circuits are known. Indeed, embodiments of the present invention are intended to work with these circuits as people can inadvertently trip these circuits without knowing so unlike a total power outage. Nordling fails to resolve the deficiencies of the primary reference. Further, one of skill in the art would not have found the claimed subject matter obvious based on Nordling even combined with Sanders. Claims 20 and 23 are restated here for ease of discussion.

20. A power disruption alert device according to Claim 1, wherein the device is configured to connect to a wall panel outlet in communication with a GFI circuit, and wherein the device is configured to mount to the wall panel outlet to allow visual access to a manual GFI reset associated with the GFI circuit.

23. A method according to Claim 22, wherein the mounting step is carried out by mounting the device to a wall panel outlet having a GFI circuit in a compact manner whereby the device occupies only a portion of a electrical outlet cover panel and allows visual access to a GFI reset on the cover panel.

Applicant submits that even combined, the references fail to teach or suggest at least the features emphasized above.

### IV. Hindsight

Selective combination of references based only on the suggestions of the instant application is improper. "Hindsight is a tempting but forbidden zone." *Loctite Corp. v. Ultraseal Ltd.*, 228 USPQ 90, 98 (Fed. Cir. 1985). Further, simplicity alone cannot be determinative of obviousness. *Gentry Gallery, Inc. v. Berkline Corp.*, 45 USPQ2d 1498 (Fed. Cir. 1998). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the

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combination. See M.P.E.P. § 2143.01(citing *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990)). As emphasized by the Court of Appeals for the Federal Circuit, to support combining references, evidence of a suggestion, teaching, or motivation to combine must be clear and particular, and this requirement for clear and particular evidence is not met by broad and conclusory statements about the teachings of references. *In re Dembiczak*, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999). In another decision, the Court of Appeals for the Federal Circuit has stated that, to support combining or modifying references, there must be particular evidence from the prior art as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed. *In re Kotzab*, 55 U.S.P.Q.2d 1313, 1317 (Fed. Cir. 2000).

Furthermore, as stated by the Federal Circuit with regard to the selection and combination of references:

This factual question of motivation is material to patentability, and could not be resolved on subjective belief and unknown authority. It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher." *W.L. Gore v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983). Thus the Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion....

*In re Sang Su Lee*, 277 F.3d 1338, 1343 (Fed. Cir. 2002).



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#### IV. Conclusion

Accordingly, Applicant submits that the present application is in condition for allowance and the same is earnestly solicited. Should the Examiner have any matters outstanding of resolution, he is encouraged to telephone the undersigned at 919-854-1400 for expeditious handling.

Respectfully submitted,

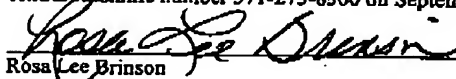


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